

### **Remarks**

This preliminary amendment is submitted upon request for continued examination and in response to the official action mailed July 31, 2006.

The claims have been amended to more particularly and distinctly define the subject matter of the invention and more clearly to distinguish over the prior art of record. Claim 1 has been amended to include inventive aspects that render the invention useful as a flush mounting box for plumbing elements. The invention claimed as a whole is not disclosed or suggested by prior art electrical boxes of US Patents 2,143,517 – Huff, 754,414 – Bossert, and/or 4,053,082 – Ullman, or by the telescopic shipping container of 4,046,279 - Rösler.

Claim 1 as amended recites the protruding mounting eyes 2 and the fitting apertures 3, that are shown in Figs. 2, 6, 8 (etc.) and are described, for example, at page 5, lines 15-23 (paragraph [0031] as published).

This amendment is consistent with applicant's previous election of Figs. 6-8 and claims 1-4, 10 and 12-15 responsive to the Restriction Requirement under 35 U.S.C. §121. The elected and nonelected embodiments all include the protruding eyes 2 and side wall apertures 3 as disclosed and claimed.

The protruding eyes 2 as disclosed and claimed are adjacent to the base of the flush-mounting box, i.e., at the bottom of the side walls and opposite from the edge at the open front. The eyes 2 provide an attachment by which the box can be affixed at the base.

The apertures 3 are parts of the fittings for installing plumbing elements, and are expressly located in the side walls of the mounting box. This location of the apertures 3

is consistent with the fact that the protruding eyes are adjacent to the base and provide attachments by which the base can be affixed to a surface.

Unlike electrical junction boxes, applicant's plumbing mounting box is securely mountable by the eyes, for example with the base placed on the surface of an underlying wall surface, stud or the like. The conduit connections thus arrive at the side walls and not at the base or bottom of the junction box. The point is that applicant's box need not be structurally carried on an outer wall (such as drywall panel) in the way that an electrical box might be mounted with electrical lines emerging at the rear. Applicant's invention comprises protruding ears 2, useful for bolting the box directly to an underlying wall or via standoffs at a distance from the underlying wall. The box is securely mounted in this way. The connections to plumbing conduits (water pipes) are made at the side walls.

A number of the references cited in the rejections under 35 U.S.C. §§102 and 103 are electrical junction boxes. However the invention as now claimed distinguishes from the prior art with respect to claimed structural aspects, and not whether the box is intended for water supply or electric power lines. The prior art does not teach or suggest the invention claimed as a whole.

The cited Huff reference was considered in the official action to anticipate the invention defined by claims 1, 2, 4, 10, 12 and 15. These claims all depend directly or indirectly from claim 1. The examiner has taken the position that the fact that Huff's flange can be turned over provides a means by which the flange is attachable at a selected certain distance from the front edge, even though the slots 3 for tabs 4 in Huff are all at one invariable distance. Turning over Huff's flange allows the flange to reside either on the inside or outside of the supporting drywall panel, keeping the edge of the box flush with the outside surface of the panel in either case.

Clearly, Huff's box is mounted on the drywall panel. Assuming that the examiner's position regarding Huff's reversible flange is correct, the rejection has been

overcome in that Huff does not disclose or suggest the aspect of protruding eyes for mounting. Huff's box is structurally carried exclusively by attachment of the flange to the drywall panel. Huff also lacks the aspect of lateral entry apertures whereby connections are made in the sidewalls instead of the base or bottom of the box at which the box is mounted. Huff's knock-out slugs are all in the bottom of the box. Therefore, Huff does not anticipate the invention defined in claim 1 as amended.

Furthermore, there is no basis to assert that Huff would render obvious the invention claimed as a whole. Huff does not suggest that it would be desirable or possible to mount the box to an underlying surface by any means. To fasten the box to an underlying surface would obstruct the knock-out slug openings used for making connections. The whole point of Huff is to mount the box to the drywall panel using the flange. Huff does not render obvious the invention claimed as a whole.

In an alternative rejection under Section 102, claims 1-4, 10 and 16 were considered anticipated by Bossert. Reconsideration is requested.

The outlet box for interior conduits in Bossert, unlike Huff, discloses plural alternative mounting depths, selected either by threading tabs along a helical slot or by fitting a tab into a selected tee intersection along an elongated slot having plural alternatively selected levels. The selection of mounting depths is made along an elongated sleeve that is part of the same part as the flange. There is no disclosure or suggestion in Bossert of protruding eyes for attaching the base of the box to a surface. In fact, there is no disclosure in Bossert of any means affixing the base of the box to a support, thereby suggesting, in the same way as Huff, that the junction box is to be carried only by the drywall panel, and only by attachment of the flange to the drywall panel. Bossert lacks a mounting for the base of the box, as claimed, and therefore does not anticipate all the particularly stated aspects of the claimed invention under Section 102.

Bossert likewise cannot be said to suggest the claimed invention under Section 103, because there is no part or aspect that even resembles a structure for mounting the base to a surface. In the absence of any depiction or discussion in Bossert, leading routinely to applicant's protruding eyes as claimed, there is no basis to assert that applicant's invention as a whole would have been known or obvious.

Claims 1, 3, 4 and 7-9 were rejected as anticipated by Ullman. As with the references already discussed, Ullman lacks any disclosure or suggestion of a flush mounting box having structures by which the base or bottom of the box is fixed to an underlying surface. Like Huff and Bossert, Ullman structurally attaches the box to the panel 14, in which a hole is formed for flush mounting the edge of the box using the flange. Ullman lacks protruding eyes for supporting the box on a rear surface, supporting the base of the box in conjunction with a flange that has variable depths at which the flange can be positioned on the box. Ullman fails to disclose or suggest applicant's claimed invention for the same reasons as set forth above. Reconsideration is requested as to each of the rejections under Section 102. There is no proper basis for a rejection under either Section 102 or Section 103.

In the rejection of claims 16-18 under Section 103, a combination of Ullman and Rösler is posited, the official action expending several paragraphs in an effort to apply selected aspects of Rösler to modify Ullman. However there is no showing of record that the person of ordinary skill would find any reason to modify an electrical junction box to adopt aspects of a telescoping shipping container. Even assuming that the combination was considered, there is no showing that the combination could include protruding eyes for affixing the combination to a rear surface. The fact that Rösler teaches a shipping container makes it all the more dubious to suggest that it would be routine selectively to modify Ullman's junction box to add an apparently redundant structure that renders the combination stationary.

Ullman discloses clamping a threaded flange and a flange on the box on opposite sides of the edges of an opening in a panel 14. The panel resembles a drywall panel in context. Even accepting the combination proposed in the official action, the resulting structure clamps exclusively to the panel 14. The combination lacks a disclosure or suggestion or incentive even to consider the possibility of protruding eyes for mounting a box to an underlying structure as claimed.

The cited references demonstrate varying ways for an installer to choose whether the flange will reside on one side of a drywall panel or the other (Huff) and varying ways for the flange and the box to be positioned relative to one another to complement the thickness of the panel, with the flange on one side of the panel and the box on the other side. The prior art boxes are carried on the outer-facing panel structure of drywall or the like. The prior art fails to disclose, and instead teaches away from a box with a repositionable flange as claimed, wherein the box also has protruding eyes at the base of the box for mounting to underlying structures that are spaced behind the outer-facing panel. Applicant's product is structurally different from the prior art, including by protruding eyes at the base and side fitting apertures. Due to applicant's structural differences, structural security is obtained that is advantageous for plumbing connections. Applicant's box can be base-mounted securely on a surface at an uncertain distance behind the drywall panel or other outer facing panel structure. These aspects are not found in the prior art, and the invention as a whole is not shown to have been obvious.

The claims have been amended for definiteness and to better distinguish over the prior art of record. The differences between the invention and the prior art are such that the subject matter claimed, as a whole, is not shown to have been known or obvious.

The application is in condition for allowance. Reconsideration and allowance are requested.

Respectfully submitted,

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/Stephan Gribok/  
Stephan P. Gribok, Reg. No. 29,643  
Duane Morris LLP  
30 South 17<sup>th</sup> Street  
Philadelphia, PA 19103-4196  
tel. 215-979-1283  
fax. 215-979-1020  
spgribok@duanemorris.com

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